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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,070	08/15/2001	Senaka Balasuriya	CAS0049	9568
20280	7590	03/10/2005	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			TRAN, NGHI V	
		ART UNIT	PAPER NUMBER	
		2151		

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/930,070	BALASURIYA, SENAKA
	Examiner Nghi V Tran	Art Unit 2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 February 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 2-20 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. This office action is in response to the Amendment filed on February 16, 2005. Claims 1-20 are presented for further examination. The Applicant has canceled claims 21-23.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuoka et al., U.S. Patent Number 6,671,508 (hereinafter Mitsuoka), in view of Wu, U.S. Patent Number 5,933,477.

4. Taking claim 1 as an exemplary claim, Mitsuoka teaches a method for selecting and executing an action in a communication node (see abstract and fig.29), the communication node (104) in communication with at least a schedule database (142) and a rules database, comprising:

- receiving (i.e. collects user status) an incoming communication directed to a subscriber (col.32, lns.51-65);

- determining a status of the subscriber (fig.29);
- accessing the rules database (fig.2A i.e. “the rule database” is interpreted as “phone book”), the rules database having a rule set of the subscriber (col.16, Ins.40-52);
- selecting an action based on the rule set of the subscriber using the subscriber status (col.33, Ins.6-42); and
- executing the action (col.33, Ins.6-42).

However, Mitsuoka is silent on determining a communication priority of the incoming communication; and selecting an action based on the rule set of the subscriber using the communication priority.

In a method for selecting and executing an action in a communication node, Wu discloses determining (i.e. “if the message does have an associated priority”) a communication priority of the incoming communication (col.4, Ins.51-58); and selecting an action based on the rule set of the subscriber using the communication priority (see abstract; and figs. 3 and 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Mitsuoka in view of Wu by determining a communication priority and selecting an action based on the communication priority because this feature “allows communications to be treated with different (e.g., increasing) urgency as a certain (“expiration”) time approaches (We, col.1, Ins.43-45). It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Mitsuoka in view of Wu in order to “delivered according

to whichever one of a plurality of different schemes indicate a highest urgency of the communication" (Wu, col.2, Ins.8-10).

5. With respect to claim 2, Mitsuoka further teaches the rule set is a predetermined rule set (column 17, lines 50-66).
6. With respect to claim 3, Wu further teaches the communication priority of the incoming communication is based on at least one of a caller identity, a device identity, a network identity, a location identity and a priority value (figures 6-7; and column 3 lines 6-55).
7. With respect to claim 4, Mitsuoka further teaches the subscriber status includes location information (figures 4-5; and column 17 lines 50-66).
8. With respect to claim 5, Mitsuoka further teaches the subscriber status includes presence information (figures 4 and 8).
9. With respect to claim 6, Mitsuoka further teaches the presence information is provided by a presence engine (column 22 lines 18-41 and column 23 lines 1-20).
10. With respect to claim 7, Mitsuoka further teaches the location information is determined from the schedule database (figure 18).

11. With respect to claim 8, Mitsuoka further teaches the location information is provided by a location determining system (see Mitsuoka's claim 14).

12. With respect to claim 9, Mitsuoka fails to teach the time being used to determine the subscriber status of the subscriber. However, Mitsuoka clearly teaches the incoming communication. In the wireless communication method, Wu discloses the incoming communication occurs at a time, the time being used to determine the subscriber status of the subscriber (figure 5). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Mitsuoka in view of Wu by specifying the time being used to determine the subscriber status of the subscriber. The motivation for doing so would have been obvious because this feature indicates the current status of the subscriber.

13. With respect to claim 10, Mitsuoka fails to teach the subscriber status includes priority information. However, Mitsuoka clearly teaches the subscriber status includes the information from at least one of the schedule database (115 and 142), a location engine (112 and 113), a presence engine and the subscriber. In the wireless communication method, Wu discloses the subscriber status includes priority information (figure 5; and column 3 lines 6-55).

14. With respect to claim 11, Wu further teaches the selection of the action is based on a comparison of the communication priority and the subscriber status (column 4 lines 34-58).

15. With respect to claim 12, Mitsuoka further teaches the action includes at least one of playing back a message of the subscriber, recording a message of the caller (column 16 lines 10-24), providing a pager number of the subscriber to the caller (figure 6), executing a page to the subscriber, executing a wire-line connection to the subscriber (105), executing a wireless connection to the subscriber (101), and providing subscriber status (115 and 142), location and contact information to the caller (figures 2A and 4).

16. With respect to claim 13, Mitsuoka further teaches receiving subscriber dynamic feedback in response to the action (column 22 lines 17-42); and executing a subsequent action based on the rule set responsive to the dynamic feedback (column 17 lines 50-66 and figure 4).

17. Claims 14-20 are also rejected for the same reason set forth in claims 1-13 above.

Response to Arguments

18. Applicant's arguments filed February 16, 2005 have been fully considered but they are not persuasive. Mitsuoka teaches selecting an action based on the rule set of the subscriber using the subscriber status (col.33, Ins.6-42). However, Mitsuoka is silent on determining a communication priority of the incoming communication; and selecting an action based on the rule set of the subscriber using the communication priority. In a method for selecting and executing an action in a communication node, Wu discloses determining (i.e. "if the message does have an associated priority") a communication priority of the incoming communication (col.4, Ins.51-58); and selecting an action based on the rule set of the subscriber using the communication priority (see abstract; and figs. 3 and 5).

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Mitsuoka in view of Wu by determining a communication priority and selecting an action based on the communication priority because this feature "allows communications to be treated with different (e.g., increasing) urgency as a certain

(“expiration”) time approaches (We, col.1, Ins.43-45). It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Mitsuoka in view of Wu in order to “delivered according to whichever one of a plurality of different schemes indicate a highest urgency of the communication” (Wu, col.2, Ins.8-10).

20. In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. See *In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "System and method for urgent phone message delivery," by Rodriguez et al., U.S. Patent Application Publication No. 2002/0067806.
- b. "System and methods for per use message delivery," by Contractor, U.S. Patent Application Publication No. 2002/0136366.
- c. "Integration of a computer-based message priority system with mobile electronic devices," by Horvitz, U.S. Patent No. 6,714,967.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi V Tran
Patent Examiner
Art Unit 2151

NT



WILLIAM A. CUCHLINSKI, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100